

REMARKS/ARGUMENTS

Claims have been amended to further define the invention. No new matter has been incorporated by these amendments.

RESTRICTION REQUIREMENT

The Examiner made a restriction requirement in the present application under 35 U.S.C. §121. The Examiner held that the subject matter of Group I, claims 11-27, drawn to a coaxial cable and Group II, claims 28-40, drawn to a method of making coaxial cable, are independent and distinct, not prosecutable in a single application. Applicants confirm their telephonic election with traverse, to prosecute the Group I, claims 11-27, drawn to coaxial cable.

The restriction requirement is respectfully traversed. In the present case, as the reasons why Group I and Group II are independent and distinct, the Examiner asserts that each group has attained recognition in the art as a separate subject for inventive effort and separate field of search as evidenced by the separate classification of each group.

However, Group I requires the combination with Group II as discussed in the Applicants' specification. These groups are related as combination/subcombination. The requisite distinctness to support the restriction requirement has not been shown because the combination as claimed requires the particulars of the subcombination. Irrespective of whether the subcombination has utility either by itself or in other different relations, a two way distinctness which was required has not been shown.

Moreover, the Examiner's allegation that the groups are classified separately is not conclusive of the independence of the invention. The classification system is primarily arranged for convenient searching and not necessarily to distinguish separate inventions. Applicants submit that Groups I and II are not distinct as the Examiner has alleged, but rather represent one single inventive concept warranting examination in a single application. Applicants submit that, in order to consider the invention herein claimed, the subject matter of the indicated Groups I-II should be considered together.

Finally, MPEP §821.04 provides that if Group I, claims 11-27, drawn to coaxial cable were found allowable, pursuant to procedures set forth in Official Gazette notice dated March 26, 1996 (1184 O.G. 86), Group II, claims 28-40, drawn to the method of

making the coaxial cable which was withdrawn from consideration as a result of restriction requirement should be rejoined and the restriction requirement should be withdrawn.

In view of the above, withdrawal of the restriction requirement is respectfully requested.

35 U.S.C. § 112

Claims 11-27 were rejected under 35 U.S.C. § 112, second paragraph as being indefinite. Claims 1 and 21 have been amended to further define the invention. Accordingly, the withdrawal of the rejection under 35 U.S.C. § 112, second paragraph is respectfully requested.

35 U.S.C. § 103

A. Claims 11-13, 16-18, 20 and 23-25 are rejected under 35 USC § 103 (a) as being unpatentable over Chan et al. (U.S. 5,486,648) in view of Goehlich (U.S. 6,784,371).

Chan et al. (U.S. 5,486,648)

Chan et al. (U.S. 5,486,648) discloses a) a cable having a core (solid or stranded conductor made of copper or aluminum); b) a semi-conductor shield layer made of semi-conductive polymeric compound such as crosslinked polyolefin (XLPE, ethylene propylene rubber (EPR) or ethylene vinyl acetate); c) an insulation layer over shield layer such as polyethylene, XLPE, EPR or the like; d) a semi-conductive insulation shield over the insulation layer and e) concentric neutral wires (CN) as metallic ground shield applied helically over cable core.

In contrast, the presently claimed invention is directed to a dry water resistant coaxial cable comprising a metal core conductor element; a dielectric element around the core conductor based on three layers, comprising: a) a first layer comprising a polymer mixed with an adhesive component and applied onto the core conductor as a uniform film; b) a second layer comprising a cellular high expansion polymer and a swelling agent on the first layer; and c) optionally, a third layer comprising a mixed polymer reinforcement layer and adhesive on the second layer. Moreover, the cable further

comprises a second external conductor surrounding the dielectric element; a second conductor element on the second external conductor, a water penetration protective element; and a protective cover surrounding the second conductor element.

The main objective of Chan et al. is to provide a longitudinal waterblock power cable having concentric neutral wires (CN) as metallic ground shield. Several arrangements of incorporating the CN were disclosed in col. 3, lines 5-54. For example, 1.) the water swellable element is helically wound around the core under CN with a lay opposite to CN thereby crisscrossing the CN wires; 2) the water swellable element is wound over and under the CN wires; 3.) the swellable element is wound on the cable core under the CN with a lay opposite of CN while other element may be wound on the core parallel to the CN wires; 4) the swellable element is helically wound around each CN wire. There could be any desired combination of the different arrangements.

It is submitted that the configuration of the cable in Chan et al. is totally different from the configuration of the coaxial cable of the present invention. The concentric neutral wires surround the insulation shield, semiconductive shield and conductor. Note Figure 2. Moreover, there is no disclosure or suggestion in Chan et al. regarding adhesives and other layers such as second external conductor and second conductor of the present invention.

Goehlich (U.S. 6,784,371)

Similarly, Goehlich (U.S. 6,784,371) is directed to power cables comprising a cable core, inner cable sheath, an outer sheath and a sensor. Goehlich has a different configuration as compared to the cable of the present invention. The cable contains a sensor for detecting a detectable substance such as water inside the cable. The object of Goehlich is to provide a cable which meets the requirements of *detecting* water in the interstices between the outer sheath, i.e., plastic and inner sheath, i.e. metal or plastic. Thus, there is a "structured material" between the inner cable sheath and the outer sheath to allow detectable substance. The invention of Goehlich centers on "structured material". The "structured material may include a) swellable material; b) self adhesive; c) one or more tapes; d) sputtered tape; d) stripe shaped tape; e) sealing material.

The prior art must provide motivation for one to modify the known product in

such a manner as to arrive at the claimed product of the present invention. See In re Laskowski, 10 USPQ seq. 2 1397 (Fed. Cir. 1989). In a case where the prior art does not appreciate the existence of the problem solved by the invention, the applicants' recognition of the problem is, in itself, strong evidence of the non-obviousness of the invention. *In re Nomiya*, 184 U.S.P.Q. 607 (CCPA 1975).

Accordingly, it is submitted that there is no motivation or suggestion in the prior art to combine the two different cables of Chan et al. and Goehlich et al. and arrive at the presently claimed invention. Applicants request the withdrawal of the rejection of claims 11-13, 16-18, 20 and 23-25 are rejected under 35 USC § 103 (a) as being unpatentable over Chan et al. (U.S. 5,486,648) in view of Goehlich (U.S. 6,784,371).

B. Claims 14-15, 19, 21-22 and 26-27 are rejected under 35 USC§ 103 (a) as being unpatentable over Chan et al. (U.S. 5,486,648) in view of Goehlich (U.S. 6,784,371) and further in view of Belli (U.S.6,455,769).

Belli (U.S.6,455,769)

The arguments above apply to this rejection.

In Belli (U.S.6,455,769), is directed to a cable comprising a conductor, an inner semi-conductive layer; insulating layer; compact semi-conductive layer; expanded layer; metal shield and an outer sheath. Belli discloses the use of fillers. Note col. 6, lines 49-51. As disclosed in the specification, Applicants have developed a technique through the design of a dry coaxial cable *without the use of fillers*. Note page 2, last paragraph. Thus, Belli teaches away from the present invention. Accordingly, there is no motivation or suggestion to combine Belli with Chan and arrive at the presently claimed invention.

In *In re Rinehart*, 189 USPQ 143 (CCPA 1976), the CCPA clarified that it was improper to maintain an obviousness rejection where the "problem is nowhere alluded to in either reference and of course no suggestion of a solution in either reference."

Moreover, it is impermissible to pick and choose from a reference only so much of it as will support a conclusion of obviousness to the exclusion of other parts necessary to a full appreciation of what the reference fairly suggests to one skilled in the art. *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 230 U.S.P.Q. 416 (Fed. Cir. 1986).

In re Lionel Yanez MARTINEZ
Serial No. 10/613,433
Amendment dated 3/16/05

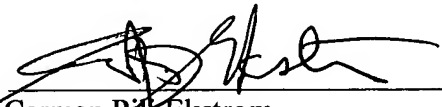
Applying the case law to the present invention, it is submitted that the object of the present invention is to prepare a dry water resistant coaxial cable without the use of fillers. Moreover, the presently claimed invention has a different configuration as compared to configuration of Belli et al.

Accordingly Applicants request the withdrawal of the rejection of claims 14-15, 19, 21-22 and 26-27 under 35 USC§ 103 (a) as being unpatentable over Chan et al. (U.S. 5,486,648) in view of Goehlich (U.S. 6,784,371) and further in view of Belli (U.S.6,455,769).

In view of the above remarks, it is respectfully submitted that the claims are in condition for examination. In the event that there are any problems which can be expedited by telephone conference, the Examiner is invited to telephone the Applicant's undersigned attorney at the telephone number listed below.

Respectfully submitted,
LAW OFFICE OF CARMEN PILI EKSTROM

Enclosures: Replacement Sheets
Attorney Docket No. MX/JFC-Serv-001
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Amendments to the Drawings

Please replace Figures 1 and 2 with the attached Figures 1 and 2 replacement sheets.